



24 JAN 2007

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In re Application of GRIFFIN et al :
U.S. Application No.: 10/544,118 :
PCT Application No.: PCT/AU2004/000098 :
Int. Filing Date: 29 January 2004 :
Priority Date Claimed: 31 January 2003 : DECISION
Attorney Docket No.: 4670-09US (600193-023) :
For: METHOD AND SYSTEM OF MEASURING :
AND RECORDING USER DATA IN A :
COMMUNICATIONS NETWORK :

This is in response to applicant's "Petition for Filing Where an Inventor Cannot Be Reached Pursuant to 37 CFR 1.47 and MPEP §409.03(b)" filed 09 January 2007.

BACKGROUND

On 29 January 2004, applicant filed international application PCT/AU2004/000098, which claimed priority of an earlier Australia application filed 31 January 2003. A copy of the international application was communicated to the USPTO from the International Bureau on 12 August 2004. The thirty-month period for paying the basic national fee in the United States expired on 01 August 2005 (31 July 2005 was a Sunday).

On 01 August 2005, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 05 June 2006, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 09 January 2007, applicant filed the present petition under 37 CFR 1.47(b).

DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by: (1) the fee under 37 CFR 1.17(i), (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage. See 37 CFR 1.47(b).

With regard to item (1) above, the requisite fee has been provided.

With regard to item (2) above, MPEP 409.03(d) states in relevant part,

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, an affidavit or declaration of facts should be submitted which fully describes the exact facts which are relied on to establish that a diligent effort was made. . . . The affidavit or declaration of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as certified mail return receipt, cover letter of instructions, telegrams, etc., that support a finding that the nonsigning inventor could not be found or reached should be made part of the affidavit or declaration. It is important that the affidavit or declaration contain statements of fact as opposed to conclusions.

The petition states that joint inventors John Griffin and Mark Long cannot be reached after diligent effort. However, documentary evidence of the purported attempts to locate the inventors has not been furnished. Although the petition states that applicant attempted to contact the inventors by telephone on several occasions, an affidavit from the person who made the calls has not been provided. Furthermore, copies of the electronic mail messages sent to the inventors have not been submitted. Moreover, the petition fails to describe and document any additional attempts to reach the inventors, i.e. by postal mail to the last known address, by searching telephone and Internet directories, and by contacting the inventors' former employer or co-workers. Thus, it would not be reasonable at the present time to conclude that the inventors cannot be found after diligent effort.

With regard to item (3) above, the petition states the last known address of the nonsigning inventors.

With regard to item (4) above, an oath or declaration executed by the 37 CFR 1.47(b) applicant on behalf of and as agent for the nonsigning inventors has not been provided. Petitioner is advised that when an assignee files an application under 37 CFR 1.47(b), ownership of the application must be established. See MPEP 324. Under 37 CFR 3.73(b)(1), ownership of the application may be established by: (i) submitting documentary evidence of a chain of title from the original owner to the assignee; or (ii) specifying by reel and frame number where such evidence is recorded in the USPTO.

With regard to item (5) above, the 37 CFR 1.47(b) applicant must prove that, as of the date the application was deposited in the Patent and Trademark Office, (A) the invention has been assigned to the applicant, or (B) the inventor has agreed in writing to assign the invention to the applicant, or (C) the applicant otherwise has sufficient proprietary interest in the subject matter to justify filing of the application. MPEP 409.03(f).

In the present case, although the petition states that the inventors have executed a written assignment, a copy of such assignment agreement has not been provided.


With regard to item (6) above, the requisite showing has not been provided.

CONCLUSION

For the reasons above, the petition under 37 CFR 1.47(b) is DISMISSED without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file a proper response will result in ABANDONMENT of the application. Extensions of time under 37 CFR 1.136(a) are available. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)." No additional petition fee is required.

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.


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